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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 97,022-N2)

PATENT

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In application of:

Rickik N. Ghosh et al.

Serial No. 09/716,732

Filed: November 20, 2000

For: A System for Cell-Based Screening

Examiner: Lisa V. Cook

Group Art Unit: 1641

Commissioner for Patents
Washington, D.C. 20231

TRANSMITTAL LETTER

In regard to the above identified application:

1. We are transmitting herewith the attached:
 - a. Information Disclosure Statement (IDS) (7 pages);
 - b. Form PTO-1449 including (Sheets 1-16 including 127 cited References);
 - c. PCT International Search Report for Application No. PCT/US00/21416; and
 - d. Return Receipt Postcard.
2. With respect to fees:

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3. Please charge any additional fees or credit overpayment to Deposit Account No. 13-2490. A duplicate copy of this sheet is enclosed.
4. **CERTIFICATE OF MAILING BY "EXPRESS MAIL" UNDER 37 CFR § 1.10:**

The undersigned hereby certifies that this Transmittal Letter and the papers, as described hereinabove, are being deposited with the United States Postal Service with sufficient postage as "Express Mail Post Office to Addressee" in a box addressed to:
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By: 
David Harper

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PATENT

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MW

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Pursuant to 37 C.F.R. Section 1.97 - 1.99, the Applicant wishes to make the following references of record in the above-identified application. This Information Disclosure Statement is in compliance with the continuing duty of candor as set forth in 37 C.F.R. Section 1.56. Copies of the references cited below are enclosed. These references are also listed on the enclosed PTO Form 1449.

In the judgment of the undersigned, portions of the listed references may be material to the Examiner's consideration of the presently pending claims. However, the references have not been reviewed in sufficient detail to make any other representation and, in particular, no representation is intended as to the relative relevance between references, whether cited in this or prior statements. This statement is not a representation that the listed references have effective dates early enough to be "prior art" within the meaning of 35 U.S.C. Section 102 or Section 103.

United States Patents

1. Horan et al., United States Patent No. 4,762,701, issued August 9, 1988.
2. Horan et al., United States Patent No. 4,783,401, issued November 8, 1998.
3. Horan et al., United States Patent No. 4,859,584, issued August 22, 1989.
4. Harpold et al., United States Patent No. 5,401,629, issued March 28, 1995.
5. Harpold et al., United States Patent No. 5,436,128, issued July 25, 1995.
6. Chalfie et al., United States Patent No. 5,491,084, issued February 13, 1996.
7. Epstein et al., United States Patent No. 5,599,681, issued February 4, 1997.
8. Dunlay et al., United States Patent No. 5,989,835, issued November 23, 1999.
9. Taylor, United States Patent No. 6,103,479, issued August 15, 2000.

Foreign Documents

10. Ward et al., WO 95/21191, published August 10, 1995.
11. Lee et al., WO 96/09598, published March 28, 1996.
12. Thastrup et al., WO 96/23898, published August 8, 1996.
13. Haseloff et al., WO 96/27675, published September 12, 1996.
14. MacAulay, et al., WO 97/43732, published November 20, 1997.
15. Dunlay, et al., WO 98/38490, published September 3, 1998.
16. Dunlay et al., WO 00/17643, published March 30, 2000.
17. Guiliano et al., WO 00/26408, published May 11, 2000.
18. Rubin et al., WO 00/03246, published January 20, 2000.
19. Giuliano et al., WO 00/50872, published August 31, 2000.
20. Olson et al., WO 00/70342, published November 23, 2000.
21. Rubin et al., WO 00/79241, published December 28, 2000.
22. Ghosh et al., WO 01/11340, published February 15, 2001.
23. Shopoff et al., WO 01/11341, published February 15, 2001.
24. Ghosh et al., WO 01/35072, published May 17, 2001.
25. Sammak et al., WO 01/42786, published June 14, 2001.

Other Documents

26. Baldwin, (1996), *Annu Rev Immunol*, 14:649-681.
27. Barak et al., (1997), *J. Biol. Chem.*, 272(44):27497-27500.
28. Barber et al., (1996), *Neuroscience Letters*, 207:17-20.
29. Beggs (1997), *J. of Biomolec. Screening*, 2(2):71-78.
30. Bislang et al., (1999), *J. Neuroscience Methods*, 92:75-85.
31. Bright et al., (1987), *J. Cell Biol.*, 104:1019-1033.
32. Bright et al., (1989), *J. Cell. Physiol.*, 141:410-419.
33. Bright et al., (1989), *Methods in Cell Biology*, 30:157-192.
34. Bright et al., (1996), *Cytometry*, 24:226-233.
35. Brugmans et al., (1983), *Cytometry*, 3: (4), pp. 262-268.
36. Cellomics, Inc., "*Neurite Outgrowth*,"
http://www.cellomics.com/html/products/neurite_outgrowth.htm, 2000, pages 1-3.
37. Chalfie et al., (1994), *Science*, 263:802-805.
38. Chow et al., (1997) *Science*, 278:1638-1641.
39. Cohen, (1997), *Biochemical J.*, 326:1-16.
40. Coso et al., (1995) *Cell*, 81:1137-1146.
41. Cubitt et al., (1995), *Trends in Biochemical Science*, 20:448-455.
42. Daaka et al., (1998), *J. Biol. Chem.*, 273(2):685-688.
43. Davis et al., (1995), *Dev. Biology*, 170:726-729.
44. DeBiasio et al., (1996), *Mol. Biol. Cell*, 7:1259-1282.
45. Denk et al., (1990), *Science*, 248:73-76.
46. Deprez et al., (1997), *J. Biol. Chem.*, 272(28):17269-17275.
47. Ding et al., (1998), *J. Biol. Chem.*, 273(44):28897-28905.
48. Ellenberg et al., (1997), *J. Cell Biol.*, 138(6):1193-1206.
49. Farkas et al., (1993), *Annu. Rev. Physiol.*, 55:785-817.
50. Federov et al., (1994), *J. Mol. Biol.*, 241:480-482.
51. Firestone et al., (1991), *Cytometry*, 12:195-206.
52. Gerritsen et al., (1997), *J. of Fluorescence*, 7(1):11-15.
53. Giuliano et al., (1987), *Anal. Biochem.*, 167:362-371.
54. Giuliano et al., (1990), *Optical Microscopy for Biology*, pp. 543-557.
55. Giuliano et al., (1995), *Annu. Rev. of Biophy. and Biomol. Structure*, 24:405-434.

56. Giuliano et al., (1995), *Curr. Op. Cell Biol.*, 7:4-12.
57. Giuliano et al., (1995), *Methods in Neuroscience*, 27:1-16.
58. Giuliano, (1996), *Cell Motil. Cytoskel.*, 35:237-253.
59. Go et al., (1997), *Analytical Biochemistry*, 247:210-215.
60. Goldman et al., (1995), *Experimental Cell Research*, 221:311-319.
61. Gonzales et al., (1987), *Digital Image Processing*, pp. 391-448.
62. Gough et al., (1993), *J. Cell Biol.*, 121(5):1095-1107.
63. Graham et al., (1973), *Virology*, 52:456-467.
64. Gratton et al., (1994), *Proc. of the Microscopical Society of America*, pp. 154-155.
65. Groen et al., (1985), *Cytometry*, 6:81-91.
66. Hahn et al., (1992), *Nature*, 359:736-738.
67. Hahn et al., (1993), *Fluorescent and Luminescent Probes for Biol. Actvy.* pp. 349-359,
68. Hall et al., (1997), *Proc. Nat. Acad. Sci.*, 94:4733-4738.
69. Hall et al., (1999), *J Biol Chem.*, 274(1):376-383.
70. Han et al., (1995), *Biochim. Biophys. Acta.*, 1265:224-227.
71. Harms et al., (1984), *Cytometry*, 5:236-243.
72. Harootunian et al., (1993), *Mol. Biol. of the Cell*, 4:993-1002.
73. Heim et al., (1996), *Curr. Biol.*, 6:178-182.
74. Hoey et al., (1998), *Curr Opin Genet Dev.*, 8:582-587.
75. Htun et al., (1996), *Proc. Natl. Acad. Sci.*, 93:4845-4850.
76. Hu et al., (1995), *FEBS Letters*, 369:331-334.
77. Jaaro et al., (1997), *Proc. Natl. Acad. Sci. U.S.A.*, 94:3742-3747.
78. Johnson et al., (1996), *Cell*, 85:149-158.
79. Kaech et al., (1996), *Neuron.*, 17:1189-1199.
80. Kaether et al., (1995), *FEBS Letters*, 369:267-271.
81. Kessler et al., (1991), *Spectrochimica Acta*, 47A(2):187-192.
82. Keßler et al., (1996), *FEBS Letters*, 395:225-227.
83. Kislauskis et al., (1994), *J. Cell Biol.*, 127(2):441-451.
84. Kittler et al., (1985), *Computer Vision, Graphics, and Image Processing*, 30:125-147.
85. Kolega et al., (1993), *BioImaging*, 1:136-150.
86. Kuo et al., (1999), *Annu Rev Immunol.*, 17:149-187.
87. Lakowicz et al., (1992), *Anal. Biochem.*, 202:316-330.

88. Lambrechts et al., (1995), *Eur. J. Biochem.*, 230:281-286.
89. Lee et al., (1996), *Biochemistry*, 35:6010-6019.
90. Lee et al., (1997), *Biochemistry*, 36:2701-2708.
91. Liang et al., (1997), *J. of Molec. Biol.*, 274:291-302.
92. Liu et al., (1998), *Curr Opin Immunol.*, 10:271-278.
93. Martinez-Zaguilan et al., (1996), *Am. J. Physiol.*, 270:C1438-C1446.
94. Masuda et al., (1998), *Cell Signal.*, 10(9):599-611.
95. McCaffrey et al., (1996), *J. Biomolec. Screening*, 1(4):187-190.
96. McCann et al., (1997), *Proc. Natl. Acad. Sci.*, 94:5679-5684.
97. McNeil, (1989), *Methods in Cell Biology*, 29:153-173.
98. Morise et al., (1974), *Biochemistry*, 13(12):2656-2662.
99. Olson et al., (1995), *J. Cell Biol.*, 130(3):639-650.
100. Palm et al., (1997), *Nat. Struct. Biol.*, 4(5):361-365.
101. Paolillo et al., (1999), *J Biol Chem.*, 274(10):6546-6552.
102. Presley et al., (1997), *Nature*, 389:81-85.
103. Proffitt et al., (1996), *Cytometry*, 24:204-213.
104. Ramakers et al., (1998), *Developmental Brain Research*, 108:205-216.
105. Rao et al., (1997), *Annu Rev Immunol.*, 15:707-747.
106. Ridler et al., (1978), *IEEE Trans. Systems, Man, and Cybernetics*, 8:630-632.
107. Rizzuto et al., (1995), *Curr. Biology*, 5(6):635-642.
108. Russ, (1992), *The Image Processing Handbook*, CRC Press Inc., 225-275.
109. Schaeffer et al., (1999), *Mol Cell Biol.*, 19(4):2435-2444.
110. Self et al., (1995), *Methods in Enzymology*, 256:3-10.
111. Shimoura et al., (1988), *J. of Biochemistry*, 251:405-410.
112. Southwick et al., (1990), *Cytometry*, 11:418-430.
113. Strehlow et al., (1998), *J. Biol. Chem.*, 273(43):28049-28056.
114. Sutoh, (1982), *Biochemistry*, 21:3654-3661.
115. Tanaka et al., (1995), *Methods in Enzymology*, 256:41-49.
116. Taylor et al., (1992), *American Scientist*, 80:322-335.
117. Taylor et al., (1994), *J. Biol. Chem.*, 269(1):308-318.
118. Taylor et al., (1996), *Intl. Soc. for Optical Engineering*, 2678: 15-27.
119. Thomas et al., (1979), *Biochemistry*, 18(11):2210-2218.

120. Tibbles et al. (1999), Cell Mol Life Sci., 55:1230-1254.
121. Tsien, (1989), Methods in Cell Biology, 30:127-156.
122. Tyagi et al., (1996), Nat. Biotechnol., 14:303-308.
123. Waggoner et al., (1996), Hum. Pathol., 27:494-502.
124. Walker et al., (1993), J. Biol. Chem. 268:19552-19558.
125. Ward et al., (1980), Photochem. Photobiol., 31:611-615.
126. Welch et al., (1995), In Vitro Cell. Dev. Biol.-Animal 31:610-616.
127. Zhao et al., (1999), J. Biol Chem., 274(13):8355-8358.

Co-Pending Applications:

The Applicants hereby notify the Examiner of the following commonly owned, co-pending applications that relate to the U.S. Application Serial Nos.:

<u>Serial No.</u>	<u>Filing Date</u>	<u>Attorney Docket No.</u>
09/031,271	02/27/98	97,022-B
09/293,210	04/16/99	97,022-G

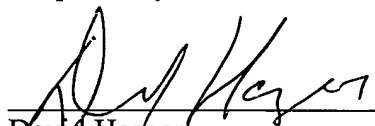
The URL cited in the International Search Report for the corresponding PCT application is listed incorrectly. The correct URL has been listed in this Information Disclosure Statement and the corresponding Form PTO-1449, citation number 36.

In accordance with MPEP Sections 609 and 707.05(b), it is requested the document cited (including any cited in applicant's specification which is not repeated on the attached Form PTO-1449) be given thorough consideration and that it be cited of record in the prosecution history of the present application by initialing on Form PTO-1449. Such initialing is requested even if the Examiner does not consider a cited document to be sufficiently pertinent to use in a rejection, or otherwise does not consider it to be prior art for any reason, or even if the Examiner does not believe that the guidelines for citation have been fully complied with. This is requested so that each document becomes listed on the face of the patent issuing on the present application.

Date: November 5, 2001

Respectfully Submitted,

By:



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